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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,824	08/25/2003	Akio Tatsumi	16869P-078300US	3627

20350 7590 09/13/2005

TOWNSEND AND TOWNSEND AND CREW, LLP  
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 EIGHTH FLOOR  
 SAN FRANCISCO, CA 94111-3834

EXAMINER
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LE, NANCY LOAN T

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/648,824

Applicant(s)

TATSUMI ET AL.

Examiner

NANCY LOAN T. LE

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to amendment filed on 17 June 2005 in which claims 1, 5, 7, 8, 14, and 19 were amended, and all other claims remain the same.

### ***Status of Claims***

2. Claims 1-23 have been examined and are pending.

### ***Response to Arguments***

3. Applicant's arguments, filed 17 June 2005 with respect to the rejection of claims 1-23 under Gold et al. (US 2002/0188704) have been fully considered and are persuasive such that *there is no teaching of modifying the program configuration of a program that operates on the modified hardware*. However, upon further consideration, a new ground(s) of rejection is made over Gold et al. in view of Lichtman et al. (U.S. Patent no. 5,787,246, published on 28 July 1998).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 1-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gold et al. (US 2002/0188704) in view of Lichtman et al. (U.S. Patent no. 5,787,246, published on 28 July 1998).

Gold et al. discloses the use of a license key to modify (upgrade) the hardware in the form of capacity limit (please see the last office action of 21 March 2005 for details).

Gold et al. do not expressly disclose when license information transmitted from the program contract renewal notification destination is inputted, modifying the hardware configuration based on the information regarding the hardware configuration to be modified and **modifying the program**

configuration of the program which operates on the modified hardware based on the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified.

Lichtman et al., however, teach when license information transmitted from the program contract renewal notification destination is inputted, modifying the hardware configuration based on the information regarding the hardware configuration to be modified and modifying the program configuration of the program which operates on the modified hardware based on the information regarding the hardware configuration to be modified and the information regarding the program configuration to be modified (i.e., *A device driver, which enables communications between the corresponding device and the computer system, is also identified for each of the devices in response to the device information. In response to the allocation of resources, the identified device drivers are loaded and the devices are activated for operation with the computer – see Abstract*), to enable another program, typically, an operating system (e.g., Windows, Linux, FreeBSD) to interact with a hardware device. A device driver, or driver for short, is essentially an instruction manual that provides the operating system with the information on how to control and communicate with a particular piece of hardware. In layman's terms, a driver is an important, vital piece to a program application; the main ingredients of the system (Wikipedia – The Free Encyclopedia, [http://en.wikipedia.org/wiki/Device\\_driver](http://en.wikipedia.org/wiki/Device_driver)).

Therefore, it would have been obvious and motivated to one of ordinary skill in the art at the time of the applicant's invention to modify a computer configuration modification method disclosed by Gold et al. to include "the modifying the program configuration of the program which operates on the modified hardware based on the information regarding the modified hardware ...", taught by Lichtman et al., to enable communications/interactions between the corresponding device and the computer system, typically, the operating system (Wikipedia – The Free Encyclopedia, [http://en.wikipedia.org/wiki/Device\\_driver](http://en.wikipedia.org/wiki/Device_driver)).

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Method for automatically configuring devices including a network adapter without manual intervention and without prior configuration information, Richman et al., U.S. Patent no. 5,655,148, published 08/05/1997.
- Device driver installing method, Kim et al., US Patent Publication no. 2002/0161939, published 10/31/2002.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday-Thursday, 7am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES P. TRAMMELL can be reached on **(571) 272-6712**. **For official/regular communication**, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**. **For informal/draft communication**, the fax number is **(571) 273-7066 (rightfax)**.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.

8. Any response to this action should be *mailed* to:

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**P.O. Box 1450**

**Alexandria, VA 22313-1450**

*Hand delivered responses* should be brought to:

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Application/Control Number: **10/648,824**

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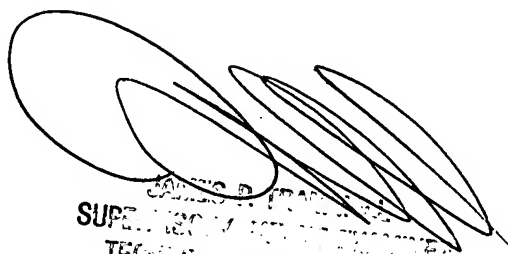
Art Unit: 3621

**401 Dulany Street**

**Alexandria, VA 22314**

NL

06 September 2005

  
SUPERVISOR  
TECHNICAL SERVICES